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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,966	04/07/2006	Maurizio Costantini	1729-437	5907
6449 7590 03/28/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER GARCIA, CARLOS E				
ART UNIT 2627		PAPER NUMBER		
NOTIFICATION DATE 03/28/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/574,966

Applicant(s)

COSTANTINI, MAURIZIO

Examiner

CARLOS E. GARCIA

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)
Paper No(s)/Mail Date 4/07/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “food product (31)” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1, and 4-6 are objected to because of the following informalities:

Claim 1 includes the term “characterised” which should be -- characterized --.

Claims 4 and 5, line 1 of each, "the" should be deleted.

Claim 5 includes the term "food product (31)". The reference numeral 31 is not shown in the Figures or disclosed in the Specification.

Claim 6 includes the term "said reinforcing adhesive means" which should be changed to -- said adhesive reinforcing means --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1: A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the

claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, line 4 recites the broad recitation "an adapter ring of flexible material", and the claim also recites "in particular cardboard" which is the narrower statement of the range/limitation.

Claim 1, line 2 and claim 6, line 3, the descriptive term "standard" renders the claims indefinite because the relative degree of the size of the component cannot be readily ascertained.

Claim 1, lines 7-8, contains the phrase "smaller than the standard size" renders the claim indefinite because the relative degree of the size of the component cannot be readily ascertained.

Claim 5, line 2, the descriptive term "small" renders the claim indefinite because the relative degree of the size of the component cannot be readily ascertained.

Claim 7 includes the term "juxtaposed arrangement" which is not thoroughly understood by the Examiner. Further clarification for which elements are arranged in a juxtaposed arrangement is required.

The claims are replete with 35 USC 112, 2nd paragraph, errors. The list above is an example of the types of errors, but is not a complete list. Applicant is required to correct all problems with indefiniteness.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuomo et al. (EP 0883126) in view of Ishioka et al. (JP 10-125026).

Re claim 1: Cuomo et al. disclose an adapter device (as shown in Figs.1-7) making it possible to use an optical memory disc of the "compact disc" type (see abs; col.1, lines 15-21) having dimensions less than a standard dimension or measure, comprising an adapter ring (adapter rings 10 or 60) of flexible material (see col.3, lines 25-28), in particular cardboard, having an outer perimeter which at least partly corresponds to the outer circumference of a standard optical disc, and an inner perimeter which at least partly corresponds to the outer circumference of the optical disc of a size smaller than the standard size (see col.3, lines 29-32); the adapter ring (either 10 or 60) being folded along a predetermined diametrical fold line (such as 16) in such a way that when in the folded configuration it presents one dimension which is close to or smaller than the external diameter of the optical memory disc of a size smaller than the standard size (folded adapter ring has a height dimension oriented perpendicular to line 16 and passing through the center of hole 14, which is less than the diameter of the disc shown in Fig.3).

However, Cuomo et al. fail to disclose or fairly suggest the adapter device characterized in that the adapter ring is essentially folded along a plurality of diametrical

directions in such a way as to form a plurality of juxtaposed segments; the outer perimeter of the adapter ring having a plurality of portions or sides, which extend essentially along chords of a circumference having a diameter corresponding to the external diameter of a standard optical disc, and a plurality of curved portions or sides corresponding to arcs of the circumference having a diameter corresponding to the external diameter of a standard optical disc; the chordal portions or sides and the curved portions or sides of the outer perimeter of the adapter ring alternating with each other; the chordal portions or sides being, in pairs, at right angles to the aforesaid diametrical fold directions.

Ishioka et al. teach an optical disk adapter 5 such as shown in Fig.4, which is formed in a space saving configuration (see abs; para.0014-0018). The shape is composed of a contour which includes an outer perimeter having a plurality of portions or sides (straight edges as shown in Fig.4), which extend essentially along chords of a circumference (see Fig.1) having a diameter corresponding to the external diameter of a standard optical disc D8, and a plurality of curved portions (curved edges as shown in Fig.4) or sides corresponding to arcs of the circumference having a diameter corresponding to the external diameter of a standard optical disc (as shown in Fig.4). Furthermore, the chordal portions or sides and the curved portions or sides of the outer perimeter of the adapter ring alternate with each other (see Fig.4), the chordal portions or sides exist in pairs (a pair of straight edges and curved edges).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the adapter ring as disclosed by Cuomo et al.

with the shape contour as taught by Ishioka et al. in order to decrease the size of the adapter ring by using a shape with one shorter dimension (such as the dimension which bisects the curved portions of adapter ring 5 shown in Fig.4 of Ishioka et al.); this dimension would allow less material to be used for the adapter ring thus reducing the overall cost of the product.

Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fold the adapter ring as disclosed by Cuomo et al. and modified by Ishioka along two diametrical directions or axes which are oriented at right angles to each other in order to further decrease the overall size of the adapter ring when the adapter ring is folded for shipping or storage, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Re claim 2: Cuomo et al. in view of Ishioka et al. as discussed above further shows the outer perimeter of the adapter ring (as shown in Fig.4) has four chordal portions or sides (four sides are comprising by the two curved edges and the two straight edges).

Re claim 3: Cuomo et al. further disclose adhesive reinforcing means (such as 62 or 12) adapted to be applied to the adapter ring 60 (same adapter ring as 10 in Fig.1A, with a modification) in its unfolded operating condition (as shown in Fig.6), and capable of preventing the tendency towards resilient return to the folded condition (see Figs.1-3; col.3, lines 36-47; col.5, lines 5-8).

Re claim 4: Cuomo et al. further discloses the adhesive reinforcing means comprise a self-stick ring 12 (see Figs.1-3; col.3, lines 36-47) which can be applied to one surface of the adapter ring (the adhesive can be placed by a user for playing the CD during operation).

Re claim 5: Cuomo et al. further disclose the reinforcing adhesive means comprise a plurality of self-stick elements 62 (see col.5, lines 5-8) of small size which can be applied over the fold zones in the adapter ring (used to maintain the adapter rigidity).

Re claim 6: Cuomo et al. further disclose an article (such as computer games or related books) for distribution in association with a commercial product ("commercial product" could be any consumer or industrial product such as discussed in col.1, lines 51-58), in particular a food product (a food product can be combined with a related book or computer product), characterized in that it comprises an optical memory disc of the "compact disc" type of a size smaller than a standard size or measure, and an associated adapter device as discussed for claim 1 above.

Re claim 7: Cuomo et al. further disclose an article (as discussed above) further comprising an enclosure (see col.3, lines 54-58; col.4, lines 1-6; commercial products such as computer software or books are typically packaged with shrink wrap or other shipping materials) capable of containing within it the optical memory disc and the

adapter ring in the folded configuration (such as in Fig.3) in a juxtaposed arrangement (the term juxtaposed does not properly describe which elements as claimed are placed in this arrangement).

Conclusion

7. The prior art made of record in PTO-892 Form and not relied upon is considered pertinent to applicant's disclosure.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos E. Garcia whose telephone number is 571-270-1354. The examiner can normally be reached on 8:30 am to 5:00 pm, Monday thru Thursday and 8:30 to 4:00 pm, Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos E Garcia/
Examiner, Art Unit 2627

3/28/2008

/Andrea L Wellington/
Supervisory Patent Examiner, Art Unit 2627